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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,129	12/27/2001	Yen Choo	8325-2001.30	1808

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PALO ALTO, CA 94303

EXAMINER

MCKELVEY, TERRY ALAN

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/033,129

**Applicant(s)**

CHOO ET AL.

**Examiner**

Terry A. McKelvey

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12/23/04, 6/17/04, and 4/1/03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18,23-41 and 104-128 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18,23-41 and 104-128 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/25/03.
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date 2/19/04
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

All objections and rejections not repeated in the instant Action have been withdrawn due to applicant's response to the previous Action.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Terminal Disclaimer***

The terminal disclaimer filed on 3/8/04 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,013,453 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Reissue Applications***

The amendment to the Sequence Listing, filed 12/23/04, proposes an amendment to the specification which do not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in reissue applications. A supplemental paper correctly amending the reissue application for this improper amendment is required.

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In the instant case, square bracketing of the material to be deleted was not performed, instead, the material to be deleted was improperly shown by strike-through. Also, the added material shown in the right side of the first page of the amended sequence listing was not shown in the proper place to be inserted. The following is how the Sequence listing should be amended in order to comply with the reissue rules and the Sequence Rules:

1. Because SEQ ID NO:2 is not set forth in the rest of the specification (it is only in Figure 2, already containing the correction), SEQ ID NO:2 must be corrected in the paper sequence listing using the reissue rules for amending the specification. In the instant case, the proposed amendment is to replace "Arg" at position 57 of SEQ ID NO:2 with "Xaa", with "Xaa" being either Arg or Lys. "Arg" should be deleted by bracketing, and the added amino acid (using the old format of the sequence rules for the identity of the amino acid) should be inserted in the same line, increasing the length of the line accordingly compared to the other lines of the sequence listing. So, in the instant case, it would be as follows:

Xaa Leu Xaa Xaa His Xaa [Arg] Xaa Thr His Thr

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It is suggested that Applicant copy the original page, white-out amino acids 57-60 in the paper sequence listing, and type " [Arg] Xaa Thr His Thr " over the white-out text, lengthening the line (and keeping "60" below "Thr").

2. The requirement for compliance with the Sequence Rules using the current "new" format is waived for reissue cases in which the original patent issued using the original "old" format. Therefore, instead of amending the entire paper sequence listing to change the paper sequence listing in the instant reissue from the old format issued in the parent patent to the new format, only the actual change to the sequence listing, like that described above, should be made by amendment to the sequence listing. In other words, the paper sequence listing may remain as an old format sequence listing, even after making an amendment to the paper sequence listing. The **computer readable form** (CRF) of the sequence listing must be in a "clean" copy incorporating the differences (i.e., not having the deleted bracketed text in the listing and not underlining the added text). The CRF must be in the same format as the paper sequence listing, so the CRF must be in the old format if the old format is retained and amended in the paper sequence listing. A new statement indicating that the amended paper sequence listing and

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CRF sequence is the same in substance and incorporates no new matter is required. See 37 CFR 1.173(b) for the precise requirements for amendments to the claims and the specification.

Any questions concerning Sequence Rules compliance should be directed to Mark Spencer whose telephone number is 571-272-2533.

The reissue oath/declarations filed 12/27/01, 1/22/02, 8/19/02, 7/9/04, and 11/26/04 are defective because:

1. They fail to state that the person signing has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration as required by 37 CFR 1.63(b)(2).

2. They fail to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.

A reissue oath/declaration or supplemental oath/declaration is required to cover every amendment to the application, including, for example, the amendments to the specification or claims filed 4/1/03 and 12/23/04, and any new amendments that are filed, such as the one correcting the sequence listing.

The reissue oath/declaration filed with this application, and the subsequent reissue oath/declarations are defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

In the instant case, the reissue oath/declarations indicate that the reissue application seeks to enlarge the scope of the original patent. However, the errors relied upon do not enlarge the scope of the patent because they are dependent claims that have all of the limitations of the claims they depend from and thus have a scope that is narrower than the original patent claims. Such claims do not enlarge the scope of the original patent.

Claims 1-18, 23-41, and 104-128 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

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"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b).

#### ***Priority***

It is noted that a cross-reference to related applications section was added by amendment on 4/1/03, referring to one additional reissue being filed, 10/309,578. This section needs to be amended to refer to all of the other reissues that were filed, and their relationship to each other, such as for applications 10/397,930 and 10/400,017.

#### ***Claim Rejections - 35 USC § 112***

Claim 113 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.



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The use of "the cell" in claim 113 renders the claim vague and indefinite because there is no positive antecedent basis for this term and thus it is unclear to which cell "the cell" refers.

### **Conclusion**

No claims are allowed.

Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone number for the Group is 571-273-8300. NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's

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Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

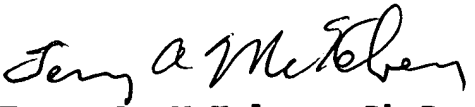
For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Any inquiry concerning rejections or objections in this communication or earlier communications from the examiner should be directed to Terry A. McKelvey whose telephone number is (571) 272-0775. The examiner can normally be reached on Monday through Friday, except for Wednesdays, from about 7:30 AM to

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about 6:00 PM. A phone message left at this number will be responded to as soon as possible (i.e., shortly after the examiner returns to his office).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel can be reached at (571) 272-0781.

  
Terry A. McKelvey, Ph.D.  
Primary Examiner  
Art Unit 1636

April 4, 2005